

## **II. Remarks**

### **A. Status of the Claims**

Claims 1-16 will be pending after entry of this amendment. Claims 1, 7 and 16 have been amended without prejudice. Support for the amendments can be found throughout the application as originally filed, specifically, e.g., paragraph [0022] of the specification. Applicants respectfully submit that no new matter has been added by virtue of this amendment.

### **B. Claim Rejections under 35 U.S.C. § 102**

In the Final Office Action, claims 1, 4-7 and 12-16 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,787,402 to Potter.

This rejection is respectfully traversed. Pursuant to MPEP § 2131, in order to anticipate and reject a claim under the provisions of 35 U.S.C. § 102, a reference must teach every element of the claim. It is well-established that a "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987).

Applicants submit that Potter fails to teach every element of the present claims, specifically the limitation that the structures of the claimed methods are capable of transmitting trade data to a pricing system via email or an email attachment.

Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 102(b) be removed.

### **C. Claim Rejections under 35 U.S.C. § 103**

In the Final Office Action, claims 2-3 and 8-11 were rejected as being unpatentable over U.S. Patent No. 5,787,402 to Potter in view of U.S. Patent Application Publication No. 2002/0156719 to Finebaum.

This rejection is respectfully traversed. Applicants submit that the combined teachings of Potter and Finebaum fail to render obvious the computer implemented methods for pricing a trade, as presently claimed. The Examiner is reminded that pursuant to MPEP, 8<sup>th</sup> Ed., 7<sup>th</sup> Rev. §

2142, to establish a prima facie case of obviousness, and thus sustain the rejection of a claim under 35 U.S.C. § 103(a), there must be a clear articulation of the reasons why Applicants' claimed invention would have been obvious. *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). The Supreme Court in *KSR* has further noted that an analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit. Therefore, it is clear that an obviousness rejection "cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006). Moreover, "[t]o support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *MPEP*, 8<sup>th</sup> Ed. 7<sup>th</sup> Rev. § 706.02(j).

Specifically, the combination of Potter and Finebaum fail to obviate the claimed limitation that the structures of the claimed method are capable of transmitting trade data to a pricing system via email or an email attachment. Applicants submit that the inventors of the present application have discovered a unique and convenient way in which to price trades through a system capable of allowing a user to send pricing requests via email directly to a financial institution. "[U]npriced trades can be exported from [the system] and attached to or included in an email". Specification at paragraph [0022]. This inventive method alleviates previously existing problems in the art by avoiding the potential errors associated with a middle-man, *while still maintaining personal interaction*, via email, with a sales or marketing person at the financial institution. See, e.g., id. at paragraphs [0004]-[0005]. Such personal interaction is important because it "provides the customer with advice and the financial institution with customer loyalty". Id. at paragraph [0004]. Applicants submit that the methods of Potter and Finebaum fail to provide the important personal interaction achieved by the claimed invention, let alone the claimed limitation of transmitting trade data to a pricing system via email or an email attachment.

Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) over Potter in view of Finebaum be removed.

### **III. Conclusion**

In view of the amendments made and arguments presented, it is believed that all claims are in condition for allowance. If the Examiner believes that issues may be resolved by a telephone interview, the Examiner is invited to telephone the undersigned at (973)597-6162. The undersigned also may be contacted via email at [epietrowski@lowenstein.com](mailto:epietrowski@lowenstein.com). All correspondence should be directed to our address listed below.

### **AUTHORIZATION**

The Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to Deposit Account No. 50-1358.

Respectfully submitted,  
Lowenstein Sandler PC

Date: July 22, 2009

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